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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92052727
Party	Plaintiff Qwest Communications International Inc.
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Submission	Motion to Amend Pleading/Amended Pleading
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Date	07/14/2010
Attachments	Optoquest Amended Pet for Cancellation 071410.pdf (18 pages)(464003 bytes)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Registration No. 2968170
For the Mark OPTOQUEST
Registered: July 12, 2005

QWEST COMMUNICATIONS
INTERNATIONAL INC.,
1801 CALIFORNIA ST.
DENVER, CO 80202

PETITIONER.

v.

OPTOQUEST Co., Ltd.
Japanese Corporation
1-19-2 Asamadai Ageo-shi
JAPAN 362-0073

RESPONDENT.

Cancellation No. 92052727

Commissioner for Trademarks
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

FIRST AMENDED PETITION TO CANCEL

Qwest Communications International Inc. (“Petitioner”), a corporation duly organized and existing under the laws of the State of Delaware, having its headquarters at 1801 California Street, Denver, Colorado, seeks relief from damage by the continued registration of the mark shown in U.S. Registration No. 2,968,170 (“Registration”) and hereby petitions for cancellation of same, including all of the goods in class 9.

As grounds for cancellation, Petitioner alleges:

1. Petitioner and its affiliated companies (including, but not limited to, Qwest Corporation and Qwest Communications Company LLC) are now and have been for many years continuously engaged in the business of advertising, promoting and selling a wide variety of telecommunication-related services and goods.
2. Petitioner is the owner of U.S. Registration No. 1,966,694, registered April 9, 1996, for the mark QWEST for “telecommunication services, namely the electronic transmission of voice, data and messages,” in class 38. This registration is valid, subsisting, incontestable and in full force and effect. As such, the registration serves as evidence of Petitioner’s exclusive right to use the mark. True copy of this registration is attached as Exhibit A.
3. Since at least as early as 1981, Petitioner and its affiliated companies have continuously used the mark QWEST in connection with “telecommunication services, namely the electronic transmission of voice data and messages.”
4. Petitioner is the owner of U.S. Registration No. 2,210,992, registered December 15, 1998, for the mark QWEST for “telecommunication services, namely, long distance telephone services, and electronic transmission of voice, data and messages” in class 38. This registration is valid, subsisting, incontestable and in full force and effect. As such, the registration serves as evidence of Petitioner’s exclusive right to use the mark. True copy of this registration is attached as Exhibit B.
5. Petitioner and its affiliated companies have continuously used the mark QWEST in connection with “telecommunication services, namely, long distance telephone services and electronic transmission of voice, data and messages” since at least as early as October 6, 1997.

6. Petitioner is the owner of U.S. Registration No. 2,727,556 for the mark QWEST for “Computer software, namely electronic mail software for sending, receiving and managing electronic mail messages” in class 9. This registration is valid, subsisting, incontestable and in full force and effect. As such, the registration serves as evidence of Petitioner’s exclusive right to use the mark. True copy of this registration is attached as Exhibit C.
7. Petitioner and its affiliated companies have continuously used the mark QWEST in connection with “Computer software, namely electronic mail software for sending, receiving and managing electronic mail messages” since as least as early as August 2000.
8. Petitioner is the owner of U.S. Application No. 78124398 for the mark QWEST in connection with, *inter alia*, a “house mark for a full line of telecommunication equipment and telecommunications software” in class 9. The application was filed on April 26, 2002 claiming a first use date of June 30, 2000. True copy of this application is attached as Exhibit D.
9. On October 29, 2002, Respondent filed an application to register the mark OPTOQUEST for certain goods in class 9. The registration issued on July 12, 2005 in connection with the following goods: Optical communications components, namely, optical multiplexers/demultiplexers, optical wavelength filters, optical isolators, optical circulators, polarization beam combiners, optical splitters, polarization controllers, optical delay lines, optical attenuators, optical fibers with a lens, and optical wave plates; Optical power meters and detectors, namely, optical pulse-duration monitors, polarization monitors, polarization-dependent meters and

detectors, and photocurrent sensors; Laser beam sources, namely, tunable laser sources and pulse-width compressors; Optical fiber related equipment, namely, spools for storing optical fibers and winding devices for optical fibers; Optical waveguide plates, namely, plastic optical waveguides.

10. Prior to Respondent's claimed first use date in commerce of March 19, 2002, Petitioner has continuously used the mark QWEST in commerce in connection with telecommunication-related goods and services.
11. Prior to the filing of the registration herein challenged, Respondent had knowledge of Petitioner's QWEST registered marks.
12. Prior to the filing date of the registration herein challenged, Respondent had knowledge that Petitioner used the mark QWEST in connection with telecommunications goods and services in the United States.
13. Upon information and belief, the "OPTO" portion of Respondent's mark refers to OPTICAL and is therefore descriptive of some or all aspects of the goods Respondent provides under its mark. Accordingly, the predominant and distinctive portion of Respondent's mark is the term "QUEST."
14. Respondent's mark, OPTOQUEST, is highly similar in sound, meaning and appearance to Petitioner's QWEST trademarks and will be used on goods that are closely related to the goods and services on which Petitioner uses its registered QWEST marks. Based on the similarity of the marks and the named goods and services, the public is likely to associate the goods offered by Respondent under the mark OPTOQUEST with Petitioner or Petitioner's goods and services, or to believe

- that Respondent's goods are sponsored, endorsed or licensed by Petitioner, or that there is some relationship between Respondent and Petitioner.
15. The goods of Respondent as noted in the subject registration and the goods and services of the Petitioner as listed in the registrations and application attached as Exhibits A-D are closely related. They each involve telecommunications-related goods and services.
16. The goods of Respondent and the goods and services of the Petitioner may be promoted and sold to the same customers through the same channels of trade.
17. Petitioner invests, on average, hundreds of millions of dollars per year in advertising and marketing its services and its advertisements have won national recognition. As a result of such use, Petitioner's QWEST marks are famous and distinctive marks well known to purchasers, and acquired such fame prior to Respondent's filing date and claimed first use date.
18. Petitioner will be damaged by continued registration of Respondent's mark because the mark has and/or is likely to cause dilution of the distinctive quality of Petitioner's famous QWEST marks in violation of Section 43(c) of the Lanham Act, 15 U.S.C. § 1125(c).
19. Petitioner is likely to be damaged by the continued registration of Respondent's mark because such registration will support and assist Respondent in the confusing and misleading use of Respondent's mark, and will give color of exclusive statutory rights to Respondent in violation and derogation of the prior and superior rights of Petitioner.

20. For the reasons set forth above, continued use and registration of the mark

OPTOQUEST by Respondent is likely to cause confusion, cause mistake or deceive the public, and cause the public to believe that the goods sold under the OPTOQUEST mark emanate from or are otherwise sponsored by or endorsed by Petitioner, in violation of Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d).

WHEREFORE, Petitioner prays that Registration No. 2,968,170 be cancelled and that this Petition for Cancellation be sustained in favor of Petitioner.

Respectfully submitted,

QWEST COMMUNICATIONS
INTERNATIONAL INC.

Date: July 13, 2010

By: Gretchen L. Testerman

Gretchen L. Testerman
1801 California Street – Suite 900
Denver, Colorado 80202
Telephone: (303) 383-6485
Email: Gretchen.testerman@qwest.com
Attorney for Petitioner

CERTIFICATE OF SERVICE

I hereby certify that on July 14th, 2010, a true and correct copy of the foregoing FIRST AMENDED PETITION TO CANCEL was served via mail upon respondent:

Optoquest Co. Ltd

1-19-2 Asamadai

Ageo-shi

Japan 362-0073

Date: July 14th, 2010

By: Samantha House
Samantha House

EXHIBIT A



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Typed Drawing

Word Mark	QWEST
Goods and Services	IC 038. US 100 101 104. G & S: telecommunication services, namely the electronic transmission of voice, data, and messages. FIRST USE: 19810428. FIRST USE IN COMMERCE: 19851030
Mark Drawing Code	(1) TYPED DRAWING
Serial Number	74656899
Filing Date	March 6, 1995
Current Filing Basis	1A
Original Filing Basis	1A
Published for Opposition	January 16, 1996
Registration Number	1966694
Registration Date	April 9, 1996
Owner	(REGISTRANT) Qwest Communications Corporation CORPORATION DELAWARE 555 Seventeenth Street Suite 1000 Denver COLORADO 80202
	(LAST LISTED OWNER) QWEST COMMUNICATIONS INTERNATIONAL INC CORPORATION BY ASSIGNMENT DELAWARE 1801 CALIFORNIA ST. DENVER COLORADO 80202
Assignment Recorded	ASSIGNMENT RECORDED
Attorney of Record	Christine P. Searls, Gretchen L. Prochaska, David R. Halvorson
Type of Mark	SERVICE MARK
Register	PRINCIPAL
Affidavit Text	SECT 8 (6-YR). SECTION 8(10-YR) 20050907.
Renewal	1ST RENEWAL 20050907
Live/Dead Indicator	LIVE

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EXHIBIT B



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Qwest

Word Mark	QWEST
Goods and Services	IC 038. US 100 101 104. G & S: TELECOMMUNICATION SERVICES, NAMELY, LONG DISTANCE TELEPHONE SERVICES, AND ELECTRONIC TRANSMISSION OF VOICE, DATA AND MESSAGES. FIRST USE: 19971006. FIRST USE IN COMMERCE: 19971006
Mark Drawing Code	(5) WORDS, LETTERS, AND/OR NUMBERS IN STYLIZED FORM
Serial Number	75384354
Filing Date	November 4, 1997
Current Filing Basis	1A
Original Filing Basis	1A
Published for Opposition	September 22, 1998
Registration Number	2210992
Registration Date	December 15, 1998
Owner	(REGISTRANT) Qwest Communications International Inc. CORPORATION DELAWARE 1801 CALIFORNIA ST. Denver COLORADO 80202
Attorney of Record	Christine P. Searls
Prior Registrations	1966694;1979485;AND OTHERS
Type of Mark	SERVICE MARK
Register	PRINCIPAL

Affidavit Text SECT 15. SECT 8 (6-YR). SECTION 8(10-YR) 20071222.
Renewal 1ST RENEWAL 20071222
Live/Dead
Indicator LIVE

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Typed Drawing

Word Mark	QWEST
Goods and Services	IC 009. US 021 023 026 036 038. G & S: COMPUTER SOFTWARE, NAMELY ELECTRONIC MAIL SOFTWARE FOR SENDING, RECEIVING AND MANAGING ELECTRONIC MAIL MESSAGES. FIRST USE: 20000800. FIRST USE IN COMMERCE: 20000800
Mark Drawing Code	(1) TYPED DRAWING
Serial Number	76008697
Filing Date	March 24, 2000
Current Filing Basis	1A
Original Filing Basis	1B
Published for Opposition	February 12, 2002
Registration Number	2727556
Registration Date	June 17, 2003
Owner	(REGISTRANT) Qwest Communications International Inc. CORPORATION DELAWARE 1801 California Street Denver COLORADO 80202
Attorney of Record	Christine P. Searls, Gretchen L. Prochaska Testerman
Type of Mark	TRADEMARK
Register	PRINCIPAL
Affidavit Text	SECT 15. SECT 8 (6-YR).
Live/Dead Indicator	LIVE

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Word Mark	QWEST
Goods and Services	IC 009. US 021 023 026 036 038. G & S: House mark for a full line of telecommunication equipment and telecommunications software; and magnetically encoded prepaid telephone calling cards and credit cards. FIRST USE: 20000630. FIRST USE IN COMMERCE: 20000630
Mark Drawing Code	(1) TYPED DRAWING
Serial Number	78124398
Filing Date	April 26, 2002
Current Filing Basis	1A
Original Filing Basis	1A
Owner	(APPLICANT) Qwest Communications International Inc. CORPORATION DELAWARE 1801 California Street Denver COLORADO 80202
Attorney of Record	Christine P. Searls, Gretchen L. Prochaska, David R. Halvorson
Prior Registrations	2727556;2871999;3385279;AND OTHERS
Type of Mark	TRADEMARK
Register	PRINCIPAL
Live/Dead Indicator	LIVE

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